

**REMARKS**

Claims 1-18 and 21-83 remain pending in the application.

Claims 1, 27-32, 50, 61, 63, 65, 79 and 80-82 have been amended in an attempt to facilitate prosecution and to place the application in condition for allowance. Claims 19, 20 and 84 have been cancelled without prejudice to refile. No new matter has been introduced by these Amendments.

**I. Rejections under 35 U.S.C. 112**

The Office Action has rejected claims 81 and 82 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In view of the amendments to Claims 81 and 82 submitted herewith, it is believed that these rejections are now moot. Therefore, Applicants respectfully request that the current rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

**II. Rejections under 35 U.S.C. § 103(a)**

The Office Action has rejected Claims 1-84 as allegedly being obvious and unpatentable under 35 U.S.C. § 103(a) based on a number of grounds. As set forth in detail below, the alleged rejections of Claims 1-84 fail to satisfy these requirements and, as such, these rejections must be withdrawn.

**A. Rejections in view of U.S. Patent No. 4,173,627 (hereinafter “Madrangé”)**

The Office has rejected Claims 1-32, 36-53, 57-59, 61-62 and 73-83 as allegedly being obvious and unpatentable over the disclosure of Madrangé alone or, alternatively, further in view of JP 08187277. To that end, it is well established that a *prima facie* case of obviousness requires

that the art of record must teach or suggest the invention as a whole and there must be the requisite motivation for the alleged modification or combination proposed in the Office Action.

There is nothing in Madrange that teaches or suggests Applicants' claimed combination of ethanol and methyl acetate. Madrange discloses a hair care composition containing at least one of: (a) a lower alkanol, such as ethanol, propanol, isopropanol or butanol; (b) a solvent such as 1,1,1-trichloroethane and methylene chloride; and (c) a diluent such as a ketone, in particular acetone and methylethyl ketone; an alkyl acetate, in particular methyl acetate or ethyl acetate, or a hydrocarbon, in particular a C<sub>3</sub>-C<sub>7</sub> alkane. (col. 3, lines 37-47). Significantly, Madrange also makes clear that none of components (a), (b) or (c) is a required component. *See*, Col. 3, lines 48-52. As such, Madrange generically discloses a "laundry list" of at least 149 possible chemical combinations.<sup>1</sup> Significantly, other than the provided examples, there is no indication in Madrange as to which of the possible chemical combinations should be chosen. To that end, none of the provided examples teach or even suggest a composition comprising the claimed combination of the instant invention.

The Office actually recognizes that Madrange fails to explicitly teach the claimed combination. *See*, Office Action at page 7. However, notwithstanding this observation, the Office further contends that it still would have been obvious in view of Madrange to arrive at Applicant's claimed combination of ethanol and methyl acetate. The Office's apparent motivation for the skill artisan to select the combination of ethanol and methyl acetate from the plethora of possible combinations is that Madrange "clearly suggests the combination of at least one lower alkanol, a

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<sup>1</sup> The number 149 was calculated as follows:

Component (a) discloses 4 preferable species; component (b) discloses 2 preferable species; and component (c) discloses 9 preferable species. Accordingly, there are:

- 1) 4 times 2, or 8 combinations of only component (a) and (b).
- 2) 4 times 9, or 36 combinations of only components (a) and (c).
- 3) 2 times 9, or 18 combinations of only components (b) and (c).
- 4) 4 times 2 times 9, or 72 combinations of components (a), (b) and (c).
- 5) 4 plus 2 plus 9, or 15 possibilities of only one of components (a), (b) and (c)

Therefore, the sum of 8, 36, 18, 72, and 15 is 149.

solvent, and a ketone diluent for the liquid phase and it is readily apparent to a skilled artisan that one can have a combination of all three in the liquid phase.” *See* Office Action at page 7.

Notably absent from this statement is the precise identification of a suggestion, teaching or motivation in Madrange that would lead one of ordinary skill in the art to select Applicants specifically claimed combination of ethanol and methyl acetate. There is no required objective evidence and specific factual findings presented in the Office Action that sets forth the requisite motivation to make the proposed selection. Hence, to modify a prior art reference without evidence of such suggestion, teaching or motivation is an impermissible hindsight reconstruction and simply takes the inventor’s own disclosure as a blueprint for piecing together the prior art in an effort to defeat patentability. *See In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). Simply put, the motivation to modify the teaching of a reference cannot come from the invention itself. *See In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

The instant rejection is premised on the logic that both ethanol and methyl acetate *could* be selected from Madrange’s generic disclosure of possible combinations. However, “[t]he mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01 (emphasis in original) (citing *In re Mills*, 916, F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). There is nothing in Madrange that would teach or suggest the desirability of selecting the specific combination of ethanol and methyl acetate, as claimed.

The Office’s proposed combination of Madrange in view of JP 08187277, similarly lacks the requisite motivation required to establish a prima facie case of obviousness as described above. The teaching of JP 08187277 attempts to mask what it believes is the irritating odor of an alcohol with an alkyl acetate. To this end, the Office has once again failed to identify the precise identification of a suggestion, teaching or motivation in Madrange that would suggest the desirability of masking the allegedly irritating odor of alcohol. The absence of any evidence of such suggestion, teaching or motivation is itself evidence of an impermissible hindsight

reconstruction that simply takes the inventor's own disclosure as a blueprint for piecing together the prior art in an effort to defeat patentability.

Moreover, even assuming *arguendo* that one of ordinary skill in the art would seek to combine the teaching of Madrange with the disclosure of JP 08187277 (which he would not) the resulting combination would nonetheless fail to provide the composition recited in Applicants claims. Specifically, JP 08187277 fails to suggest what other components may be present in the composition and whether these additional components contribute to the volatile organic compound content of the composition. Thus, in the absence of any disclosure that would suggest the remaining components of the composition, JP 08187277 necessarily fails to teach or suggest a composition having any specific volatile organic compound content, much less a VOC content that does not exceed 80%.

The Office Action has also rejected several dependent claims on a number of grounds. Specifically, Claims 33-35, 56, 60 and 63-72 have been rejected under 35 U.S.C. § 103 over Madrange alone or in view of JP 08187277, in further view of Chaung; and Claims 54 and 55 have been rejected under 35 U.S.C. § 103 over Madrange alone or in view of JP 08187277, in further view of Morawsky. While Applicants do not concede or agree with these rejections, Applicants need not address the substantive merits of these rejections in detail because the teaching of Madrange, alone or further in view of JP 08187277 is insufficient to defeat the patentability of independent Claims 1 and 80 as discussed above. Accordingly, it is respectfully submitted that dependent Claims 33-35, 54-56, 60 and 63-72 are also allowable over the instant rejections. *See In re Fine*, 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.")

Claim 84 has also been rejected under 35 U.S.C. § 103 over Madrange alone or in view of JP 08187277, in further view of U.S. Patent No.: 5,866,718 (hereinafter "Prabhu"). While Applicants do not agree with or concede the Office's position in this regard, the cancellation of Claim 84 submitted herewith renders this rejection moot.

**B. Rejections in view of U.S. Patent No. 4,243,548 (hereinafter “Heeb”)**

The Office has also rejected Claims 1-51, 56-57, 61-72 and 76-84 as allegedly being obvious and unpatentable over the disclosure of Heeb alone or, alternatively, further in view of JP 08187277. As discussed above, a *prima facie* case of obviousness requires that the art of record must teach or suggest the invention as a whole and there must be the requisite motivation for the alleged modification or combination proposed in the Office Action. There is nothing in Heeb that teaches or suggests a composition comprising Applicants’ claimed combination of ethanol and methyl acetate.

Specifically, Heeb discloses a pressurized aerosol formulation comprising at least one of 23 possible solvents that can be used alone or in combination. Considering instances of one solvent alone and only those possible combinations of any two listed solvents, Heeb similarly discloses a generic “laundry list” of **at least 276** possible combinations.<sup>2</sup> Significantly, other than the provided examples, there is no indication in Heeb as to which of the possible chemical combinations should be chosen. Moreover, none of the provided examples provide the requisite motivation for the skilled artisan to select Applicants’ claimed combination of ethanol and methyl acetate.

Once again, the Office recognizes that Heeb fails to explicitly teach the claimed combination. *See* Office Action at page 12. However, notwithstanding this observation, the Office again contends that it still would have been obvious in view of Heeb to arrive at Applicant’s claimed combination of ethanol and methyl acetate. The Office’s apparent motivation for the skill

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<sup>2</sup> The number 276 was calculated using the following formula:

$$n!/[(n-r)!r!]$$

wherein “n” is the total number of elements (in this case 23 species) and “r” is the number of elements in the subset (in this case a combination of any 2 species). Therefore,

$$23!/[(23-2)!2!] = 253$$

However, there are also 23 possibilities if only one of the 23 species is used. Therefore, 253 + 23 = 276.

artisan to select the combination of ethanol and methyl acetate from the plethora of possible combinations is that Heeb “teaches the use of ethyl acetate or methyl acetate as solvents and specifically utilizes ethyl acetate and isopropanol. Thus, a skilled artisan can readily ascertain that Heeb’s exemplified ethyl acetate may be substituted with instant methyl acetate with an expectation of similar results...” *See* Office Action at page 12.

Again, notably absent from this statement is the precise identification of a suggestion, teaching or motivation in Heeb that would lead one of ordinary skill in the art to select Applicants specifically claimed combination of ethanol and methyl acetate. There is no required objective evidence and specific factual findings presented in the Office Action that sets forth the requisite motivation to make the proposed selection. Thus, the instant rejection is again merely premised on the logic that both ethanol and methyl acetate *could* be selected from Heeb’s generic disclosure of possible combinations. However, as stated above, “[t]he mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01 (emphasis in original) (citing *In re Mills*, 916, F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Further, the Office specifically relies on Heeb’s Example 16 for its alleged teaching of methyl acetate in a room deodorant composition. However, contrary to the Office’s assertion, Example 16 does not disclose a room deodorant composition comprising methyl acetate. Rather, Example 16 is limited to the procedure of Example 6 wherein the isopropanol component of Example 6 is substituted with a mixture of ethanol and isopropanol. Thus, it is apparent that the Office has misinterpreted Heeb’s discussion of further experiments, separate and distinct from Examples 1-16. While the use of methyl acetate is suggested for use in these further experiments, there is no teaching or suggestion in these additional examples to select methyl acetate in combination with ethanol. *See* Col 8, lines 8-38.

Moreover, evening assuming arguendo that one of skill in the art would have been motivated to select the claimed combination of ethanol and methyl acetate (which he would not),

the resulting composition would not comprise at least 5 weight percent methyl acetate as recited in the instant claims. Heeb's suggestion to utilize methyl acetate specifically states that methyl acetate can only be used in combination with 1,1,1 trichloroethane in an amount **up to 4.36** percent by weight. See Col. 8 lines 34-35. Thus, notwithstanding Heeb's failure to suggest the claimed combination of ethanol and methyl acetate, Heeb expressly teaches away from any composition comprising methyl acetate in an amount of at least 5 weight percent.

Likewise, the Office's proposed combination of Heeb in view of JP 08187277 similarly lacks the requisite motivation required to establish a prima facie case of obviousness as described above. As previously discussed, the teaching of JP 08187277 is directed to masking what it believes is the irritating odor of an alcohol with an alkyl acetate. The Office's has once again failed to identify the precise identification of a suggestion, teaching or motivation in Heeb that would suggest the desirability of masking the allegedly irritating odor of alcohol. Thus, without the requisite motivation in Heeb seek guidance in masking the allegedly irritating odor of an alkanol, one of skill in the art would not seek to combine these unrelated disclosures. This absence of the requisite evidence of such suggestion, teaching or motivation in Heeb is itself evidence of the Office's improper hindsight reconstruction that has simply taken the Applicants' own disclosure as a blueprint for piecing together the prior art in an effort to defeat patentability.

Claim 84 has also been rejected under 35 U.S.C. § 103 over Heeb alone or in view of JP 08187277. Once again, while Applicants do not agree with or concede the Office's position in this regard, the cancellation of Claim 84 submitted herewith renders this rejection moot.

### **III. Obvious-type Double Patenting Rejections**

The Office has also rejected Claims 1-84 as allegedly being unpatentable under the judicially created doctrine of obviousness-type double patenting in view of U.S. Patent No. 6,752,983. While Applicants do not concede or agree with this rejection, a Terminal Disclaimer of the instant application is submitted herewith for the sole purpose of facilitating prosecution and placing the application in condition for allowance.

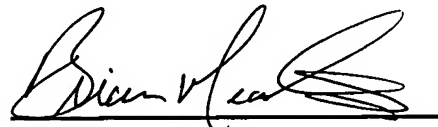
CONCLUSION

In view of the Amendments and Remarks set out above, it is respectfully asserted that the rejections set forth in the Office Action of February 22, 2005 have been overcome and that the application is in condition for allowance. Accordingly, Applicants respectfully seek notification of same.

A Credit Card Payment Form PTO-2038 authorizing payment in the amount of \$580.00, representing \$450.00 for the requisite two month extension of time fee and \$130.00 for the requisite terminal disclaimer fee is enclosed. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.

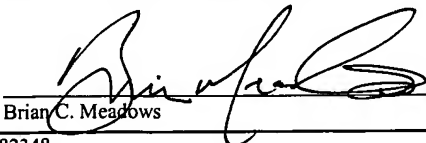


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